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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,063	08/27/2003	Brad Rake	8121.15132-CIP 2 DIV	4631

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EXAMINER	
HANSEN, COLBY M	

ART UNIT	PAPER NUMBER
3682	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/649,063	RAKE ET AL.	
	Examiner	Art Unit	
	Colby Hansen	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 August 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "sensor" being directly connected to the device, as claimed in claims 1-6, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Nowhere within the specification is a sensor directly connected to a device to be lubricant disclosed or implied.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere within the original specification or drawings is the sensor directly connected to the device for lubrication.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 1-6, applicant claims sensing mechanisms with the intended use of sensing the humidity within a device to be lubricated; applicant then positively recites the devices and their "enclosed spaces" within the claim limitations. Consequently, the scope of the claim language is unclear.

Furthermore, with regard to claim 6, applicant claims a "sensor", then attempts to further limit "said sensor" as comprising a "stand alone humidity sensing mechanism". Are these not one and the same component? Furthermore, how does a sensor comprise a housing defining the enclosed space when the enclosed space is directed to the "individually monitored device"?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by applicant's disclosure of the EMD-2000 humidity sensor (page 14/lines 6-15).

Applicant appears to be claiming the subcombination of a sensor in claims 1-4 and 6, which was known to be sold within the United States before the invention of applicant's mechanism. While an "enclosed space" is not disclosed in the specification, with reference to the EMD-2000 sensor, such a limitation is an intended use recitation directed to "the device", therefor the sensor must only be capable of performing said function, which it is, given its chemical resistance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregory et al. (US Pat. 5,125,480) in view of Reichert (US Pat. 5,330,636).

Gregory et al (US Pat. 5,125,480) discloses a lubricant sensing mechanism for sensing a physical lubricant condition of a lubricant, said lubricant sensing mechanism comprising:

A housing containing a mechanism desired to be lubricated (equipment bearings as disclosed in abstract);

A lubricant contained within said housing (inherent);

A stand alone, lubricant condition sensing module coupled to said housing (fig. 1);

Said lubricant condition sensing module measuring a lubricant condition within said housing (as broadly recited, it does sample the lubricant within the equipment to be lubricated), said sensing mechanism programmed to communicate at least one actuating signal to said signal mechanism upon sensing a predetermined lubricant condition;

An alarm indicator communicatively coupled with said sensors;

The physical lubricant condition senses at least one of temperature, pressure, vibration, viscosity, and power.

Gregory et al (US Pat. 5,125,480) discloses the claimed invention except for the sensing of water content within the lubricant in terms of percentage of saturation.

Reichert (US Pat. 5,330,636) discloses a lubricant sensing mechanism comprising a physical lubricant condition sensor for water content in terms of percentage of saturation wherein the processor includes a comparator to compare the measured value to a selected reference set point and generate a deviation, and further including an output for the deviation (col.3/line 59 to col. 4/ line 18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the water content sensor mechanism of Reichert (US Pat. 5,330,636) within Gregory et al (US Pat. 5,125,480) so as to more effectively recondition lubricants to reduce lubricant costs, keep operators apprised of dangerous humidity conditions, equipment maintenance costs, laboratory costs, etc, as suggested by Reichert (US Pat. 5,330,636), in col. 3/ lines 1-23. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have fixtured the sensors within the enclosed space of Gregory et al. (US Pat. 5,125,480) by screwing said sensors into the side of the enclosed space so as to allow to modular assembly of parts such that should a sensor malfunction it may be replaced; thereby fulfilling the limitation of said humidity sensor being coupled to the enclosed space, as broadly recited.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregory et al. (US Pat. 5,125,480) in view of Reichert (US Pat. 5,330,636), further in view of Mizumoto et al. (US Pat. 5,080,195).

Gregory et al. (US Pat. 5,125,480) in view of Reichert (US Pat. 5,330,636) disclose the claimed invention except for applicant's overly specific interpretation (which as explained in the 35 USC 112, 1st paragraph rejection above is unsubstantiated by the original specification) of the sensing mechanism being "directly" connected to the device.

Mizumoto et al. (US Pat. 5,080,195) discloses a sensor directly connected to a bearing assembly so to send real time feedback to a lubricant supplying means, which may then determine the proper amount and characteristics to be supplied to the device.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the sensing mechanism configuration of Mizumoto et al. (US Pat. 5,080,195) within Gregory et al. (US Pat. 5,125,480), so as to enhance the level of reliability of the device to be lubricated, as suggested by Mizumoto et al. (US Pat. 5,080,195).

Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizumoto et al. (US Pat. 5,080,195) in view of Reichert (US Pat. 5,330,636).

Mizumoto et al. (US Pat. 5,080,195) discloses the claimed invention except for the sensing of water content within the lubricant in terms of percentage of saturation.

Reichert (US Pat. 5,330,636) discloses a lubricant sensing mechanism comprising a physical lubricant condition sensor for water content in terms of percentage of saturation wherein the processor includes a comparator to compare the measured value to a selected reference set

point and generate a deviation, and further including an output for the deviation (col.3/line 59 to col. 4/ line 18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the water content sensor mechanism of Reichert (US Pat. 5,330,636) within Gregory et al (US Pat. 5,125,480) so as to more effectively recondition lubricants to reduce lubricant costs, keep operators apprised of dangerous humidity conditions, equipment maintenance costs, laboratory costs, etc, as suggested by Reichert (US Pat. 5,330,636), in col. 3/ lines 1-23. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have fixtured the sensors within the enclosed space of Gregory et al. (US Pat. 5,125,480) by screwing said sensors into the side of the enclosed space so as to allow to modular assembly of parts such that should a sensor malfunction it may be replaced; thereby fulfilling the limitation of said humidity sensor being coupled to the enclosed space, as broadly recited.

Response to Arguments

Applicant's arguments, filed 6/24/2005, with respect to drawing objection of the "stand alone sensor" and the 35 USC 112, 2nd paragraph of said sensor have been fully considered and are persuasive. The drawing objection and 35 USC 112, 2nd paragraph rejection concerning said stand alone sensor has been withdrawn.

In response to applicant's argument that the 35 USC 102 rejection of claim 6 is improper because "applicant is not aware of a mechanism being previously used as recited in claim 5, which is as a single component of a sensor, with entire claimed sensor providing a more

accurate, individualized monitoring device than was previously known in the prior art". Examiner disagrees that the rejection is improper given that applicant admits that the intended use of the sensor (currently the claims are interpreted as being directed to the subcombination of the sensor; see the above 35 USC 112, 2nd rejection) is what is deemed patentable distinct, however it is Examiner's contention that a recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform. MPEP 2114 and Ex parte Masham, 2 USPQ 2d 1647 (1987). Furthermore, such a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Applicant argues that neither Gregory nor Reichert shows the humidity sensor being directly connected to the device that is being monitored. Firstly, it is Examiner opinion that applicant does not disclose such a limitation within the specification or drawings (fig. 1 discloses the sensor 140 being connected to a housing and not the device 14, hence the above 35 USC 112, 1st paragraph rejection). Secondly, as broadly recited, given that the lubrication device of Gregory is only part of its inherent incorporation with a device to be lubricated, it is deemed to be "directly connected to the device", as best understood.

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(571) 273-8300**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MEP. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MEP. 512). The following is an example of the format the certification might take:

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If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MEP. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Colby Hansen whose telephone number is (571) 272-7105. The examiner can normally be reached on Monday through Thursday and every other Friday from 7:30 PM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (571) 272-7099. Any inquiry of a general nature or

relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

Colby M. Hansen

8/15/05

Patent Examiner

DAVID FENSTERMACHER
PRIMARY EXAMINER 8/19/05